

Remarks

Claims 14 and 20 are currently pending in the present application. Claim 14 has been amended to include a period (.) at the end of the claim and does not alter the claim language. Applicants had previously cancelled withdrawn claims 21-23 without prejudice. Applicants maintain that claims 21 and 22 have been withdrawn at the Examiner's request to expedite prosecution and should be rejoined once 14 and 20 are found allowable.

Issue Under 35 U.S.C. §103

Claims 14 and 20 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bruce et al. (WO 03/072557). Applicants respectfully traverse this rejection. Bruce et al. published 4 September 2003 and is owned by Novartis AG. The instant application has a priority date of 28 August 2003 by virtue of filing in English in Great Britain. Therefore, Bruce et al. cannot be a section 102 (a) or (b). The 35 U.S.C. section 102 (e) date of Bruce et al. would be its international filing date of 27 February 2003. Bruce et al. qualifies as potential prior art to the instant invention under 35 U.S.C. §102(e) and the Examiner has raised a 35 U.S.C. §103(a) rejection.

Applicants assert that Bruce et al. should not preclude patentability due to the fact that both applications were assigned to the same entity, Novartis AG.

35 U.S.C. §103(c) recites the following:

- (1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.
- (2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if -
 - (A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;
 - (B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

To support this assertion Applicants submit copies of the Assignments from the inventors to Novartis AG.

Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 14 and 20.

Conclusion

Applicants respectfully submit that each issue has been addressed and overcome.
Applicants submit that the claims are in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-4409. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-4409.

If any extensions of time are needed for timely acceptance of papers submitted herewith, applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account 50-4409.


Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Customer No. 75074

August 2, 2010
Novartis Vaccines and Diagnostics, Inc.
P.O. Box 8097
Emeryville, California 94662-8097
(510) 923-3949
(510) 655-3542 (fax)

By:


Vinit Kathardekar
Attorney for Applicants
Reg. No. 39,461

ASSIGNMENT

I / We

Graham Charles BLOOMFIELD, Novartis Horsham Research Centre, Wimblehurst Road, Horsham, West Sussex RH12 5AB, Great Britain, citizen of Great Britain

Ian BRUCE, Novartis Horsham Research Centre, Wimblehurst Road, Horsham, West Sussex, RH12 5AB, Great Britain, citizen of Great Britain

Judy Fox HAYLER, Novartis Horsham Research Centre, Wimblehurst Road, Horsham, West Sussex RH12 5AB, Great Britain, citizen of Great Britain

Catherine LEBLANC, Novartis Horsham Research Centre, Wimblehurst Road, Horsham, West Sussex RH12 5AB, Great Britain, citizen of France

Darren Mark LE GRAND, Novartis Horsham Research Centre, Wimblehurst Road, Horsham, West Sussex RH12 5AB, Great Britain, citizen of Great Britain

Clive MCCARTHY, Novartis AG, Lichtstrasse 35, 4056 Basel, Switzerland, citizen of Great Britain

for good and valuable consideration, the receipt and adequacy of which is hereby acknowledged, do hereby sell and assign to **Novartis AG, a Company organized under the laws of the Swiss Confederation, of Lichtstrasse 35, 4056 Basel, Switzerland**, its successors, assigns and legal representatives all my/our right, title and interest, in and for the United States of America, in and to the invention entitled:

5-PHENYL-4-METHYL-THIAZOL-2-YL-AMINE DERIVATIVES AS INHIBITORS OF PHOSPHATIDYLINOSITOL 3 KINASE ENZYMES (PI3) FOR THE TREATMENT OF INFLAMMATORY DISEASES

invented by me/us and described in the international application

No. PT/EP2004/009586 filed 27.08.2004

and all United States Letters Patent which may be granted therefor, and all divisions, reissues, continuations and extensions thereof, the said interest being the entire ownership of the said Letters Patent when granted, to be held and enjoyed by the said **Novartis AG**, its successors, assigns or other legal representatives, to the full end of the term for which said Letters Patent may be granted, as fully and entirely as the same would have been held and enjoyed by me/us if this assignment and sale had not been made;

And I/we hereby authorize and request the Commissioner of Patents and Trademarks to issue said Letters Patent to the said **Novartis AG**.

Signed on

Graham Charles Bloomfield
Graham Charles BLOOMFIELD

18-1-06

Ian Bruce
Ian BRUCE

18-01-06

Judy Fox Hayler
Judy Fox HAYLER

3-03-06

Catherine Leblanc
Catherine LEBLANC

19-1-2006

Darren Mark Le Grand
Darren Mark LE GRAND

30-1-06

Clive MCCARTHY

Signed on

Graham Charles BLOOMFIELD

Ian BRUCE

Judy Fox HAYLER

Catherine LEBLANC

Darren Mark LE GRAND


Clive MCCARTHY

5/01/2006